

## **REMARKS**

Applicants confirm the election of claims 1 – 4 without traverse in response to the restriction requirement. Claims 1 – 4 are now pending in the application, the remaining claims having been cancelled. A minor amendment has been made to claim 2 to correct a typographical error and is not a narrowing amendment. The Examiner is respectfully requested to reconsider and withdraw the rejection(s) in view of the amendments and remarks contained herein.

## **SPECIFICATION**

In the section titled "Specification," the Examiner objected to claim 2 due to a typographical error in which the word "truck" was misspelled as "track." Applicants have amended claim 2 to correct this typographical error. Therefore, reconsideration and withdrawal of this objection are respectfully requested.]

## **REJECTION UNDER 35 U.S.C. § 101**

Claims 1 – 4 stand rejected under 35 U.S.C. § 101 as lacking technological art. The Board of Patent Appeals and Interferences recently held that there is no separate "technological arts" test for determining whether a claimed process or method constitutes patentable subject matter under § 101. *Ex parte Lundgren*, 76 USPQ2d 1385 (Bd. Pat. App. & Int. 2005). In doing so, the Board reversed a rejection that a business method directed to compensating a manager of a business firm that did not disclose or suggest any type of apparatus was not patentable subject matter under § 101. *Id.*; see also, Interim guidelines for Examination of Patent Applications for Patent

Subject Matter Eligibility, Annex III – Improper Tests for Subject Matter Eligibility, “United States patent law does not support the application of a “technical aspect” or “technological arts” requirement.” (October, 2005) A claimed invention is patent eligible subject matter “if the claimed invention physically transforms an article or physical object to a different state or thing, or if the claimed invention otherwise produces a useful, concrete, and tangible result.” *Id.* Applicants invention as claimed in claims 1 – 4 produces the useful, concrete and tangible result of sharing revenues generated from sales (claim 1) or printing (claim 3) of banners that are affixed to truck bodies. It is thus at least as useful, concrete and tangible as the compensation method at issue in *Ex parte Lundgren*. Applicants submit that claims 1 – 4 are thus drawn to patent eligible subject matter under § 101 and respectfully request withdrawal of their rejection under § 101.

#### **REJECTION UNDER 35 U.S.C. § 103**

Claims 1 – 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Oliver (U.S. Pat. Pub. 2002/0133412 A1) in view of Waters (U.S. Pat. Pub. 2002/0032659 A1). Applicants respectfully traverse this rejection.

Claims 1 and 3 are the independent claims. Each is directed to a method of sharing revenues generated from printing banners that are affixed to truck bodies. Claim 1 requires that a manufacturer of track bodies manufacture the truck bodies with mounting hardware for the banners and that the manufacturer receive a share of revenues from sales by a banner seller of banners to be affixed to such truck bodies. Claim 3 requires that a manufacturer of track bodies manufacture the truck bodies with

mounting hardware for the banners and that a printer prints the banners and shares with the manufacturer a portion of the revenues the printer receives for printing the banners.

Applicants submit that none of Oliver, Waters or the art discussed by applicants in the application (Applicants' Admitted Prior Art – AAPA) disclose or suggest such a method. In Oliver, Waters and the AAPA, revenue sharing occurs among those who participate in some fashion in the transaction that generates the revenue. For example, in Oliver, revenues from sales to registered users who access participating online information service providers is shared among those providers. In Waters, revenue generated from sales or licensing of patented ideas is shared with the inventors who submitted the ideas. In the AAPA, it is the participants in an advertisement involving placing a banner on a truck body that receive the revenue. An agent brokers a deal with an advertising agency to place an advertisement prepared by the advertising agency for an advertising client on the side of a truck body owned by a truck body owner. The advertising client pays for the advertisement and the media buy. The advertising agency is compensated for preparing the advertisement and may receive a percentage of the media buy. The media buy is with the truck owner who is paid for the placement of the advertisement on the truck body. The banner printer who prints the banner advertisement is paid to do so. The broker receives a percentage of the media buy. Each entity is thus involved in the underlying transaction(s) that result in the advertising banner being placed on the truck body.

In contrast, the truck body manufacturer is not involved in the underlying advertising transaction. Not only does it typically occur well after the truck body manufacturer has sold the truck body, but it the truck body owner that is a party to the

advertising transaction, not the truck body manufacturer. As such, applicants submit that none of the above discussed prior art discloses or suggests, alone or in combination, the above discussed limitations of claims 1 and 3.

#### **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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By: 

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